Airaz Technologies Sdn Bhd v Padzilah bt Enda & Anor

HIGH COURT (KUALA LUMPUR) — CIVIL SUIT NO WA-22IP-41–09 OF 2022
AZLAN SULAIMAN JC
13 FEBRUARY 2024

Patents — Industrial designs — Registered designs — Action by plaintiff to revoke defendants' registered industrial designs — Defendants counterclaimed against plaintiff for infringement of one of its registered industrial designs — Whether defendants' registration of industrial designs ought to be revoked — Whether there was infringement of second defendant's industrial design by plaintiff — Industrial Designs Act 1996 ss 24, 27 & 32

The plaintiff was incorporated in 2017 and its nature of business was 'Menjual dan membekal pakaian tudung, jubah'. Its products were marketed and sold under the brand name 'Inner Sejuk'. The second defendant was incorporated 17 years earlier and its nature of business was supplying and selling all kinds of garments, clothes and scarfs. Its products were marketed and sold under the brand name 'Siti Khadijah.' The defendants' three industrial designs that were registered under the Industrial Designs Act 1996 ('the Act') were in Class 02 for 'religious apparel' ('the defendants' RID') which was the telekung, a garment worn by women over their outer clothes when they perform their prayers. The three designs of the telekung had been developed into actual three-dimensional physical telekungs and had been respectively marketed and sold as 'Moden 1', 'Moden 2' and 'Harmoni', all under the brand name 'Siti Khadijah' ('the defendants' telekungs'). In November 2021, the plaintiff began producing, marketing and selling a telekung as 'Telekung Suqainah Lite' ('the plaintiff's telekung'). The second defendant issued a letter to the plaintiff alleging that the plaintiff's telekung infringed the second defendant's RID 44 and demanded that the plaintiff cease and desist from producing, marketing and selling it. Pursuant to reg 28 of the Industrial Designs Regulations 1999, the plaintiff filed this action by way of originating summons ('OS'), invoking s 27 of the Act to revoke the registration of all three of the defendants' RID. However, the court subsequently allowed the defendants' application under O 28 r 8 of the Rules of Court 2012 for the proceedings in the OS to be continued as if the action had begun by writ. The defendants counterclaimed against the plaintiff for infringement of RID 44 under s 32 of the Act.

Held:

(1) The plaintiff's case to expunge the defendants' RID under s 24(1)(a) of the Act fell outside of its pleaded case. The plaintiff could not make a

wholly different case under s 24(1)(a) of the Act when it only expressly pleaded and confined itself to s 27 of the Act in the intitulement of the OS and in the principal relief it sought in the OS. From the OS action up until now, the plaintiff had chosen to frame its action and thereby confine its claim against the defendants solely as one under s 27 of the Act. Even though the plaintiff pleaded particulars aligned with elements of s 24(1)(a) of the Act, ultimately it did not seek any relief under that section to expunge the defendants' RID from the Register. The plaintiff's attempt to make a case against the defendants under s 24(1)(a) of the Act in its written submissions was an attempt to make an argument outside its pleaded case, and could not be entertained (see paras 24–25, 28–29 & 32).

(2) The plaintiff had failed to plead sufficient particulars as to the lack of novelty in the defendants' RID. It had also failed to plead or adduce the details of the telekung that had been disclosed to the public prior to the priority date of the defendants' applications to register each of those defendants' RID that would make the defendants' RID lacking in novelty. The plaintiff further failed to adduce any samples of any alleged telekungs or physical specimens or any other evidence of any alleged telekungs that had been disclosed to the public or were already being traded in the marketplace that would render the defendants' RID to be lacking in novelty or not new. Consequently, the plaintiff had altogether failed to establish any case for alleging that the defendants' RID were not new and that their registration ought to be revoked under s 27(1)(a) of the Act. Accordingly, the plaintiff's action to revoke the registration of the defendants' RID was dismissed (see paras 41 & 44–46).

(3) The essential features of the defendants' Telekung Harmoni were present in and were essential features of the plaintiff's Telekung Suqainah Lite. On the balance of probabilities, that was the result of copying and imitation by the plaintiff of the defendants' Telekung Harmoni that had already been sold and available in the marketplace well before the plaintiff started selling the plaintiff's Telekung Suqainah Lite. In the production, marketing and selling of the telekung Suqainah Lite, the plaintiff had copied and imitated the defendants' Telekung Harmoni. On the balance of probabilities, the second defendant had successfully established and proved that the plaintiff had infringed the second defendant's RID 44. Therefore, the second defendants' counterclaim against the plaintiff was allowed (see paras 58–59).

[Bahasa Malaysia summary

Plaintif diperbadankan pada 2017 dan sifat perniagaannya adalah 'Menjual dan membekal pakaian tudung, jubah'. Produknya dipasarkan dan dijual di bawah jenama 'Inner Sejuk'. Defendan kedua telah diperbadankan 17 tahun sebelumnya dan sifat perniagaannya adalah membekal dan menjual pelbagai

jenis pakaian, pakaian dan selendang. Produknya dipasarkan dan dijual di bawah jenama 'Siti Khadijah'. Tiga reka bentuk perindustrian defendan yang didaftarkan di bawah Akta Reka Bentuk Perindustrian 1996 ('Akta') berada dalam Kelas 02 untuk 'pakaian agama' ('RID defendan') iaitu telekung, pakaian yang dipakai oleh wanita di atas pakaian luar mereka ketika mereka menunaikan solat. Tiga reka bentuk telekung telah dibentuk menjadi telekung fizikal tiga dimensi sebenar dan masing-masing telah dipasarkan dan dijual sebagai 'Moden 1', 'Moden 2' dan 'Harmoni', semuanya di bawah jenama 'Siti Khadijah' ('telekung defendan'). Pada November 2021, plaintif mula mengeluarkan, memasarkan dan menjual telekung dikenali sebagai 'Telekung Suqainah Lite' ('telekung plaintif'). Defendan kedua mengeluarkan surat kepada plaintif yang mendakwa telekung plaintif melanggar RID 44 defendan kedua dan menuntut plaintif berhenti daripada mengeluarkan, memasarkan dan menjualnya. Menurut peraturan 28 Peraturan-Peraturan Reka Bentuk Perindustrian 1999, plaintif memfailkan tindakan ini dengan cara saman pemula ('SP'), menggunakan s 27 Akta untuk membatalkan pendaftaran ketiga-tiga RID defendan. Walau bagaimanapun, mahkamah kemudiannya membenarkan permohonan defendan di bawah A 28 k 8 Kaedah-Kaedah Mahkamah 2012 untuk prosiding dalam SP diteruskan seolah-olah tindakan itu telah dimulakan secara writ. Defendan menuntut balas terhadap plaintif kerana melanggar RID 44 di bawah s 32 Akta.

Diputuskan:

(1) Kes plaintif untuk memadamkan RID defendan di bawah s 24(1)(a) Akta adalah di luar kes plidingnya. Plaintif tidak boleh berhujah yang sama sekali berbeza di bawah s 24(1)(a) Akta apabila ia hanya dengan nyata memplid dan mengehadkan dirinya kepada s 27 Akta dalam tajuk SP dan dalam relif utama yang dipohon dalam SP. Dari tindakan SP sehingga kini, plaintif telah memilih untuk merangka tindakannya dan dengan itu mengehadkan tuntutannya terhadap defendan semata-mata sebagai satu di bawah s 27 Akta. Walaupun plaintif memplid butir-butir yang selaras dengan unsur-unsur s 24(1)(a) Akta, akhirnya ia tidak mendapatkan sebarang pelepasan di bawah seksyen itu untuk memadamkan RID defendan daripada Daftar. Percubaan plaintif untuk berhujah terhadap defendan di bawah s 24(1)(a) Akta dalam hujahan bertulisnya adalah percubaan untuk membuat hujah di luar kes yang diplid, dan tidak boleh didengar (lihat perenggan 24–25, 28–29 & 32).

(2) Plaintif telah gagal mengemukakan butir-butir yang mencukupi tentang kekurangan kebaharuan dalam RID defendan. Ia juga gagal untuk memplid atau mengemukakan butiran telekung yang telah didedahkan kepada umum sebelum tarikh keutamaan permohonan defendan untuk mendaftarkan setiap RID defendan yang akan menjadikan RID defendan kurang kebaharuan. Plaintif selanjutnya gagal mengemukakan sebarang sampel telekung yang didakwa atau spesimen fizikal atau

apa-apa bukti lain tentang mana-mana telekung yang didakwa yang telah didedahkan kepada orang ramai atau telah diniagakan di pasaran yang akan menyebabkan RID defendan kurang kebaharuan atau bukan baru. Akibatnya, plaintif sama sekali gagal untuk membuktikan sebarang kes kerana mendakwa bahawa RID defendan bukan baharu dan pendaftaran mereka sepatutnya dibatalkan di bawah s 27(1)(a) Akta. Sehubungan itu, tindakan plaintif untuk membatalkan pendaftaran RID defendan telah ditolak (lihat perenggan 41 & 44–46).

(3) Ciri-ciri penting Telekung Harmoni defendan terdapat dalam dan merupakan ciri penting Telekung Suqainah Lite plaintif. Atas imbangan kebarangkalian, ia adalah hasil penyalinan dan peniruan oleh plaintif Telekung Harmoni defendan yang telah dijual dan boleh didapati di pasaran sebelum plaintif mula menjual Telekung Suqainah Lite plaintif. Dalam pengeluaran, pemasaran dan penjualan telekung Suqainah Lite, plaintif telah menyalin dan meniru Telekung Harmoni defendan. Atas imbangan kebarangkalian, defendan kedua telah berjaya membuktikan bahawa plaintif telah melanggar RID 44 defendan kedua. Oleh itu, tuntutan balas defendan kedua terhadap plaintif dibenarkan (lihat perenggan 58–59).]

Cases referred to

Dart Industries Inc & Anor v CMN International Sdn Bhd & Ors [2019] MLJU 1252, HC (refd)

F&N Dairies (Malaysia) Sdn Bhd v Tropicana Products, Inc and other appeals [2013] MLJU 1591; [2013] 1 LNS 380, CA (refd)

LB (Lian Bee) Confectionery Sdn Bhd v QAF Ltd [2012] 4 MLJ 20, FC (refd)

Redland Tiles Ltd & Ors v Kua Hong Brick Tile Works [1966] 2 MLJ 62 (refd)

YKL Engineering Sdn Bhd v Sungei Kahang Palm Oil Sdn Bhd & Anor [2022] 6 MLJ 1, FC (folld)

Legislation referred to

Industrial Designs Act 1996 ss 3, 12, 24, 24(1), 24(1)(a), 27, 27(1), (1)(a), (1)(b), (1)(c), (1)(d), 32, 32(1), (2), (2)(a), 33, 33(1), 35, Part VI

Industrial Designs Regulations 1999 reg 28

Rules of Court 2012 O 18, O 28 r 8

Trade Marks Act 1976 (repealed by Trademarks Act 2019) s 46(1)(b)

Nik Mohamed Ikhwan bin Nik Mahamud (with Nur Nazuha bt Zohar Ali and Ummi Salhah bt Mohamad) (Nazuha Law Chambers) for the plaintiff.

Ahmad Hafiz bin Zubir (with Iman Danial Hakim bin Md Azam and Ahmad Zuhairi) (Hafiz Zubir & Co) for the defendant.

Azlan Sulaiman JC:

A. INTRODUCTION

[1] In his book 'The Art of War', Sun Tzu (544–496 BC), Chinese military general, strategist, philosopher and writer, wrote that 'Attack is the secret of defence; defence is the planning of an attack'. In modern times it has been adapted into the adage, 'The best defence is a good offence'. In German, it has been abbreviated even further, into 'gegenpressing', and has been applied to great success by another 'general' and strategist, currently commanding a football club situated on one side of Stanley Park in Merseyside, England.

[2] The plaintiff here looks to have taken Sun Tzu's principle on board. The defendants between them have registered three industrial designs under the Industrial Designs Act 1996 ('the Act'). Upon the plaintiff receiving a demand from them to cease and desist from infringing one of them, the plaintiff launched an offensive by filing this action to revoke all three of them under s 27 of the Act. The defendants naturally counterclaimed against the plaintiff for infringement of that one of its registered industrial designs under s 32 of the Act.

[3] If the plaintiff is successful and the defendants' three registered industrial designs are revoked, there would be no issue of infringement as there would be no registered industrial design to infringe. The flip-side is that, if the plaintiff fails in that quest, it faces the possibility of being liable to the defendants for damages and other relief for industrial design infringement, not to mention the costs of bringing this action.

[4] Given the fact that a successful revocation of the registered designs may decide the whole action and obviate the need to even consider the counterclaim for infringement, the issue of invalidation will be considered and decided first. However, before getting ahead of ourselves by diving into that issue, it may be opportune to first set out the salient facts.

B. SALIENT FACTS

[5] The plaintiff was incorporated on 18 August 2017. Its nature of business is 'Menjual dan membekal pakaian tudung, jubah'. Its products are marketed and sold under the brand name 'Inner Sejuk'. Trademarks for the same logo and word mark 'Inner Sejuk' have been registered in 2017 in Classes 35 and 25, the latter being for 'Clothing, footwear, headgear, innerware, underwear, all included in Class 25'. Both trademarks are registered in the name of one Azrul Izzam bin Kamarul Zaman ('Azrul Izzam') trading as Airaz Industries. However, even though Azrul Izzam is the Executive

Chairman, Managing Director and shareholder of the plaintiff and testified at the trial, the plaintiff did not adduce any evidence of any of those trademarks being transferred or assigned by him to it and registered in its own name.

[6] The second defendant was incorporated almost seventeen years earlier on 2 November 2000 and the first defendant is one of its directors. The nature of the second defendant's business is 'To supply and selling all kinds of garments, clothes and scarf E-commerce and online, manufacturing and logistics, general trading and services, properties investment'. Its products are marketed and sold under the brand name 'Siti Khadijah'.

[7] The defendants' three industrial designs that are registered under the Act are in Class 02 for 'Religious Apparel' (collectively 'defendant's RID'). The religious apparel here is the 'telekung', a garment worn by women over their outer clothes when they perform their prayers. The registration details of the defendants' RID are set out in Table A below:

No	Registration number	Registration date	Owner
1	MY 11-01679-0101 ('RID 1679')	17 November 2011	D1
2	MY 15-01173-0101 ('RID 1173')	5 October 2015	D2
3	MY 16-00044-0101 ('RID 44')	11 January 2016	D2

[8] The three designs of the telekung have been developed into actual three-dimensional physical telekungs and have been respectively marketed and sold as 'Moden 1', 'Moden 2' and 'Harmoni', all under the brand name 'Siti Khadijah' (collectively, 'defendants' Telekungs').

[9] In November 2021, the plaintiff began producing, marketing and selling a telekung as 'Telekung Suqainah Lite' ('plaintiffs' Telekung').

[10] On 22 March 2022, solicitors for the second defendant issued a letter to the plaintiff alleging that the plaintiff's Telekung infringed the second defendant's RID 44 and demanded that the plaintiff cease and desist from producing, marketing and selling it.

[11] On 2 June 2022, pursuant to reg 28 of the Industrial Designs Regulations 1999 ('Regulations') the plaintiff filed this action by way of Originating Summons ('the OS'), invoking s 27 of the Act to revoke the registration of all three of the defendants' RID. However, this court subsequently allowed the defendants' application under O 28 r 8 of the Rules of Court 2012 ('the ROC') for the proceedings in the OS to be continued as if

the action had been begun by writ. Despite the court initially directing that the affidavits in support of the OS do stand as pleadings, on the parties subsequent request to file fresh pleadings under O 18 of the Rules, the court issued directions and deadlines for pleadings to be filed instead, which the parties did.

[12] In its *pernyataan tuntutan*, as per the OS, the plaintiff invoked s 27 of the Act and sought to revoke the registration of all three of the defendants' RID. In its *pernyataan pembelaan dan tuntutan bala*s the defendants have counterclaimed against the plaintiff for infringement of RID 44 under s 32 of the Act.

C. REVOCATION UNDER S 27 OF THE ACT

Setting the parameters of the plaintiff's pleaded case for revocation

[13] It is trite law that the parties to an action are bound by their rejective pleaded cases and that the court decides the action on them.

[14] The intitulement of the OS referred specifically and solely to s 27 of the Act, which is indeed for revocation of the registration of an industrial design. Prayer 1 of the OS also sought for revocation of the defendants' RID.

[15] Section 27 of the Act provides:

> Revocation of registration and grant of compulsory licence
>
> (1) At any time after the registration of an industrial design, any person may apply to the Court —
>
> (a) for the revocation of the registration of the industrial design on the ground, subject to section 12, that the industrial design has been disclosed to the public prior to the priority date of the application for registration of the industrial design;
>
> (b) for the cancellation of the registration of the industrial design on the ground that the registration of the industrial design has been procured by unlawful means; or
>
> (c) for the grant of a compulsory licence in respect of the industrial design on the ground that the industrial design is not applied in Malaysia by any industrial process or means to the article in respect of 19 which it is registered to such an extent as is reasonable in the circumstances of the case,
>
> and the Court may make such order on the application as it considers just.
>
> (2) Paragraphs (1)(a) and (1)(b) shall be without prejudice to the right of the owner of an industrial design to request the Registrar for the revocation of a registered

industrial design of which he is owner, or to the power of the Registrar to order the revocation of the registration of an industrial design on any other ground as he thinks fit.

[16] Section 27 of the Act therefore provides for the revocation of the registration of an industrial design in two instances:

(a) that the industrial design has been disclosed to the public prior to the priority date of the application for registration of the industrial design; or

(b) that the registration of the industrial design has been procured by unlawful means.

[17] In the plaintiff's 'alasan-alasan permohonan' in paras (a) to (h) of the OS, the plaintiff alleged that the defendant's RID should not have been registered because they were not new and that the defendants did not own the original design to those registered designs. Those allegations are consistent with an application to revoke the registration of industrial designs under s 27 of the Act.

[18] In its *pernyataan tuntutan*, the plaintiff again invoked s 27 of the Act to revoke the registration of the defendants' RID. In para 14(i) of the *pernyataan tuntutan* the principal relief the plaintiff seeks is indeed a revocation of the defendants' RID under s 27 of the Act, with the other relief in sub-paras (ii) to (iv) of para 14 being ancillary to that principal relief. For example, the relief sought in para 14(H) of the *pernyataan tuntutan* is for the sealed revocation order made by this court to be served on the registrar so to effect the revocation.

[19] However, the need to set the parameters of the plaintiffs pleaded case is because, in the plaintiffs' written submissions, the plaintiff's principle submission is that the registration of the defendants' RID should be revoked because they are not industrial designs within the meaning of ss 3 or 12 of the Act and therefore should not have been registered in the first place. The plaintiff essentially contends that the defendants' RID should not have been registered as they do not have any eye appeal, and are dictated solely by the function which the defendants' *telekung*s have to perform.

[20] Section 3 of the Act is the interpretation provision in the Act. For 'industrial design' it provides:

> 'industrial design' means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged by the eye, but does not include —
>
> (a) a method or principle of construction; or

(b) features of shape or configuration of an article which —

(i) are dictated solely by the function which the article has to perform; or

(ii) are dependent upon the appearance of another article of which the article is intended by the author of the design to form an integral part;

[21] Section 12 of the Act is entitled 'Registrable industrial design' and provides:

Registrable industrial design

(1) Subject to this Act, an industrial design shall not be registered unless it is new.

(2) An industrial design for which an application for registration is made shall not be considered to be new if, before the priority date of that application, it or an industrial design differing from it only in immaterial details or in features commonly used in the relevant trade —

(a) was disclosed to the public anywhere in Malaysia or elsewhere; or

(b) was the subject matter of another application for registration of an industrial design filed in Malaysia but having an earlier priority date made by a different applicant in so far as that subject matter was included in a registration granted on the basis of that other application.

(3) For the purposes of paragraph (2)(a), an industrial design shall not be deemed to have been disclosed to the public solely by reason of the fact that, within the period of six months preceding the filing date of an application for registration —

(a) it appeared in an official or officially recognized exhibition; or

(b) it has been disclosed by a person other than the applicant or his predecessor in title as a result of an unlawful act committed by that other person or another person.

[22] While the provisions of s 12 of the Act are consistent with and can be read in conjunction with an application for revocation of the registration of an industrial design under s 27(1)(a), in my view, if the plaintiffs are contending that the registration of the defendants' RID should be revoked because they do not have or are lacking in the essential characteristics of an industrial design, ie they do not have any eye appeal and are dictated solely by the function which the article has to perform, then the defendant should have further and/or in the alternative invoked s 24(1)(a) of the Act, on the ground that the defendant's RID should be expunged because they are entries made in the Register without sufficient cause and/or entries wrongfully remaining in the Register.

[23] Section 24(1)(a) of the Act provides:

> Rectification of Register
>
> (1) Subject to the provisions of this Act —
>
> (a) the Court may, on the application in the prescribed manner, of any person aggrieved by or interested in the non-inclusion in or omission from the Register of any entry, or by or in *any entry made in the Register without sufficient cause, or any entry wrongfully remaining in the Register,* or any error or defect in any entry in the Register, make such order for including, making, *expunging* or varying any such entry or for the correcting of any such error or defect as it deems fit; (Emphasis added.)

[24] In my view, the plaintiff's case to expunge the defendants' RID under s 24(1)(a) of the Act falls outside of its pleaded case. There are several reasons for saying so.

[25] Firstly, the plaintiff did not expressly plead s 24(1)(a) of the Act in either the OS or in the principal relief it sought thereunder. Though it did say 'Alasan-alasan lain yang ditegaskan dalam affidavityang diikrarkan oleh plaintifdan difailkan di sini', in my view by that statement alone, the plaintiff cannot make a wholly different case under s 24(1)(a) of the Act when it only expressly pleaded and confined itself to s 27 of the Act in the intitulement of the OS and in the principal relief it sought in the OS. The principal relief it sought in the OS was:

> Reka Bentuk Perindustrian berdaftar bernombor Pendaftaran MY 1101679-0101, MY 15-01173-0101 dan MY 16-00044-0101 yang didaftarkan di bawah nama Defendan Pertama dan/atau Defendan kedua dibatalkan dengan serta merta dan dikeluarkan dari Rekod Pendaftaran Reka Bentuk Perindustrian Malaysia yang tersimpan dalam jabatan-jabatan dan/atau perbadann Kerajaan pendaftaran yang relevan di Malaysia.

[26] Secondly, the conversion of the OS into a writ action under the O 28 r 8 of the Rules meant that the action as filed under the OS (ie an action filed under s 27 of the Act) was converted into a writ action filed under s 27 of the Act.

[27] Thirdly, in the *pernyataan tuntutan,* the plaintiff again sought and confined itself to seeking as its principal relief a declaration under s 27 of the Act, as follows:

> Satu dekalarasi di bawah Seksyen 27 Akta Reka Bentuk Perindustrian 1996 dan/atau Peraturan 28 Peraturan-peraturan Reka Bentuk Perindustrian 1999 dan/atau di bawah kuasa sedia ada dan budibicara Mahkamah yang Mulia ini agar Reka Bentuk Perindustrian berdaftar bernombor pendaftaran MY 11-01679-0101, MY 15-01173-0101 dan MY 16-00044-0101 yang didaftarkan di bawah nama Defendan Pertama dan/atau Defendan kedua dibatalkan dengan serta merta dan

dikeluarkan dari Rekod Pendaftaran Reka Bentuk Perindustrian Malaysia yang tersimpan dalam jabatan-jabatan dan/atau perbadann Kerajaan pendaftaran yang relevan di Malaysia.

[28] The word 'dibatalkan' sought in the OS and in that principal relief the *pernyataan tuntutan* is also the word used for 'revoked' in s 27 of the Act in the National Language. Evidently, from the OS action up until now, the plaintiff has chosen to frame its action and thereby confine its claim against the defendants solely as one under s 27 of the Act.

[29] Fourthly, even though the plaintiff pleaded particulars aligned with elements of s 24(1)(a) of the Act in paras 13.2 and 13.3 of its *pernyataan tuntutan*, ultimately it did not seek any relief under that section to expunge the defendants' RID from the Register. Thus, considering and deciding those allegations would ultimately come to naught.

[30] Fifthly, in *F&N Dairies (Malaysia) Sdn Bhd v Tropicana Products, Inc and other appeals* [2013] MLJU 1591; [2013] 1 LNS 380 that the plaintiff refers to, unlike here, the defendants to the plaintiff's four registered industrial design infringement suits had disputed and denied the plaintiff's allegations and had stated that the plaintiffs registered industrial design was not a valid and subsisting design in Malaysia under the Act on the grounds that:

(a) the registration of it was bad and contrary to the provisions of the Act;

(b) it consists of features of shape or configuration which are wholly dictated by the function for which it is to perform; and

(c) it is not new at its priority date.

[31] Those contentions mean that the defendants there had invoked both ss 24 and 27 of the Act to challenge the plaintiff's registered industrial design. As I had set out earlier, here the plaintiff has chosen to confine itself to s 27 of the Act, contending that the defendants' RID are not new.

[32] At the end of the day, the plaintiff's attempt to make a case against the defendants under s 24(1)(a) of the Act in its written submissions is an attempt to make an argument outside its pleaded case, and cannot be entertained.

[33] Another reason for ignoring the plaintiffs' attempt to make a case under s 24(1)(a) of the Act is the principle of construction *in bonam partem.* That principle came to the fore in the case of *LB (Lian Bee) Confectionery Sdn Bhd v QAF Ltd* [2012] 4 MLJ 20.

[34] In that case, the appellant was engaged in the business of manufacturing, producing and dealing in all kind of cakes, biscuits, bread, sweets, buns and other food-stuff in Malaysia, and had produced cream filled buns and had sold these products using the trademark 'squiggle' since November 2007. The respondent, on the other hand, owned 79% of Gardenia Bakeries (KL) Sdn Bhd ('Gardenia'), and under a licensing agreement in 1996 granted several rights to Gardenia, including the use of its trademarks, one of which was 'squiggles', that had been registered in 2004. The appellant brought an action to expunge the respondent's trademarks under s 46(1)(b) of the (then) Trade Marks Act 1976, which requires an applicant to first establish that it is an aggrieved person.

[35] The Federal Court held that, on the principle of construction *in bonam partem,* the appellant could not claim to be an aggrieved person because it was already infringing the respondent's trademark. Zulkefli CJ (Malaya) said (in paras [17] and [18] of the judgment of the Federal Court):

> We are in agreement with the learned judge's findings that as an infringer and as to what may be regarded as a 'policy' ground, the appellant cannot be regarded as a 'person aggrieved' for the purposes of s 46(1) of the TMA.
>
> There is a juristic support for this 'policy' approach by the leaned judge which was upheld by the Court of Appeal. As a matter of statutory interpretation, the courts have long applied the principle of construction *in bonam partem* ...
>
> In accordance with the principle of construction in bonam partem, it is noted that the learned trial judge had found that the appellant had been infringing the registered trademark 'squiggles' since 2007. The registered trademark 'squiggles' was registered on 20 August 2004. Until its expungement, the registered trademark remains a registered trademark. In this case, even before the application for expungement, the appellant had unlawfully been using the infringing mark 'squiggle' which is confusingly similar to the registered trademark. Applying the principle of construction in bonam partem, the appellant cannot be regarded as being a bona fide 'person aggrieved' or a person who is lawfully aggrieved for the purposes of s 46(1)(b) of the TMA. *Furthermore, if the appellant is to be regarded as a 'person aggrieved' for the purposes of* s 46(1)(b) of the TMA, it would mean that all infringers may apply to expunge the very trademark they have been infringing and this would be contrary to the time-honoured principle of not allowing them to benefit from their very own wrong or unlawful act.

[36] Even though *LB (Lian Bee) Confectionary* concerned invalidation of a trademark under the Trademarks Act 2019, I am of the view that the principle of construction *in bonam partem* can also be applied to s 24(1)(a) because an applicant there also has to 'an aggrieved person'.

[37] Further, even though s 24(1)(a) provides that it may also be invoked by 'any person interested', I further find that the principle of construction *in*

bonam partem would also apply to any such person because, by that principle, the law does not lend its assistance to anyone seeking to benefit from their very own wrong or unlawful act, not just an aggrieved person.

[38] As in Part D of this judgment I have found that the plaintiff is infringing RID 44, by the principle of construction *in bonam partem* the plaintiff cannot invoke s 24(1)(a) of the Act. That would also mean that the plaintiff cannot even invoke s 27 of the Act.

[39] Nevertheless, I will still go on to now consider whether the plaintiff has made a case for revoking the registration of the defendants' RID under any of the two grounds under s 27 of the Act. The burden of proof naturally lies on the plaintiff to do so.

Revocation of the defendants' RID under s 27

[40] The only particulars aligned with elements of a revocation under s 27 of the Act are in paras 13.1 (a) to (d) of its *pernyataan tuntutan* in which the plaintiff alleges that the defendants' RID are not new. Thus, the plaintiff is only invoking limb (a) of s 27(1) of the Act. Those particulars are set out in paras (a) to (d) as follows:

a) bahawa Reka Bentuk-Reka Bentuk Perindustrian Defendan Pertama dan/atau Defendan Kedua dan/atau Defendan-Defendan pada masa permohonan pendaftarannya bukanlah satu reka bentuk baharu ('new'); dan/atau

b) bahawa Reka Bentuk-Reka Bentuk Perindustrian Defendan Pertama dan/atau Defendan Kedua dan/atau Defendan-Defendan telah sebelum pada tarikh permohonan pendaftarannya dizahirkan kepada awam di Malaysia, reka bentuk tersebut atau suatu reka bentuk perindustrian yang berbeza daripadanya hanya dari segi butir-butir tidak material atau daripada segi ciri-ciri yang biasa digunakan dalam perdagangan yang relevan; dan/atau

c) Ciri-ciri bentuk dan konfigurasi pada Reka Bentuk-Reka Bentuk Perindustrian Defendan Pertama dan/atau Defendan Kedua dan/atau Defendan-Defendan dengan suatu reka bentuk perindustrian lain yang berbeza daripadanya hanya daripada segi butir-butir tidak material; dan/atau

d) Ciri-ciri bentuk dan konfigurasi pada Rek Reka Bentuk-Reka Bentuk Perindustrian Defendan Pertama dan/atau Defendan Kedua dan/atau Defendan-Defendan adalah ciri-ciri yang biasa digunakan dalam perdagangan yang relevan.

[41] In my view, despite these allegations, the plaintiff has failed to plead sufficient particulars as to the lack of novelty in the defendants' RID. It has also

failed to plead or adduce the details of the *telekung* that had been disclosed to the public prior to the priority date of the defendants' applications to register each of those defendants' RID that would make the defendants' RID lacking in novelty.

[42] In *YKL Engineering Sdn Bhd v Sungei Kahang Palm Oil Sdn Bhd & Anor* [2022] 6 MLJ 1, one of questions before the Federal Court was whether a party intending to challenge the novelty of a patent by relying upon evidence of prior art was required by law to have pleaded with specificity the particulars of such prior art. The Federal Court answered that question affirmatively. In paras [34] to [42] of his judgment, Azahar Mohamed CJ (Malaya) provided a comprehensive explanation for that that is worthy of being repeated verbatim. He said:

> [34] Novelty is a prerequisite for patentability. In order to consider the nature of novelty it is necessary to bear in mind the provisions of s 14 of the PA 1983. The provisions require an invention to be new in the sense that on the date of filing of patent application, it should not form a part of the state of the art. The invention is not novel if it is anticipated by prior art and prior art consists of everything disclosed to the public anywhere in the world by written publication, oral disclosure and by use or in any other way before the priority date of the patent application claiming the invention. The priority date is the date by which the novelty of the invention is to be judged. In order for any prior art to provide sufficient disclosure, the disclosure must be enabling in nature, that is to say, giving sufficient and clear instructions or teachings to arrive at the disputed invention (see *The General Tire & Rubber Company v The Firestone Tyre and Rubber Company Limited and others* [1972] RPC 457 ('General Tire & Rubber Company').
>
> [35] Undeniably, in our jurisdiction, unlike others such as the United Kingdom, Australia and Singapore, there are no specific provisions, whether in the PA 1983 and the Patents Regulations 1986 that require a party to plead with specificity the prior art a party intends to rely on to invalidate a patent for lack of novelty or otherwise. The questions therefore fall to be decided by reference to the Rules of Court 2012 ('the ROC 2012'). The order of the ROC which governs the general principles of pleadings is O 18 r 7(1). This rule lays down the requirements of the pleading, namely that pleadings should be statements in summary form, stating only the material facts in a manner which is brief and to the point, and not the evidence by which they are to be proved (see *Malaysian Civil Procedure 2021* (Sweet & Maxwell, Vol 1) para 18/7/1). Material facts are facts which are necessary for the purpose of formulating a complete cause of action and for establishing a defendant's defence (see *Bruce v Odhams Press Ltd* [1936] 1 All ER 287).
>
> [36] The question than arises: is a prior art a 'material fact' that must be pleaded with specificity by a party seeking to invalidate a patent for lack of novelty? In addressing this question, it is important to note that in a case where a party claims that a patent is not a patentable invention as it is not new and does not involve an inventive step, the parties' expert is required to provide their opinion on the relevant prior art to assist the court on the issues of invalidation of the patent validity of the patent must be assessed by the court with the aid of an expert often referred to as a

'person having ordinary skill in the art' (see *Spind Malaysia Sdn Bhd v Justrade Marketing Sdn Bhd & Anor* [2018] 4 MLJ 34 (FC) ('Spind Malaysia Sdn Bhd')). More often than not, patent litigations involved technical and complex construction of the patent itself and its specifications. The court is informed by the expert as to the meaning of technical words and phrases and what was at the relevant time, the common general knowledge as possessed by the notional skilled man or an appropriately skilled addressee (see *General Tire & Rubber Company and Kirin-Amgen Inc and others v Hoechst Marion Roussel Ltd and others; Hoechst Marion Roussei Ltd and others v Kirin-Amgen and others* [2005] 1 All ER 667). As explained by Adous J in the case of *Lubrizol Corpn v Esso Petroleum Co Ltd* [1998] RPC 727:

> Patent specifications (description) are intended to be read by persons skilled in the relevant art, but their construction is for the court. Thus, the court must adopt the mantle of the notional skilled addressee and determine, from the language used, what the notional skilled addressee would understand to be the ambit of the claim. To do that it is often necessary for the court to be informed as to the meaning of technical words and phrases and what was, at the relevant lime, the common knowledge; the knowledge that the notional skilled man would have.

[37] In our judgment, the Court of Appeal failed to appreciate that this was a patent case and that the respondents were relying on items of prior art with the object of invalidating the appellant's patent. For this reason, the importance of giving notice to the appellant by the respondents in respect of the Desa Kim Loong Machine and of specific pleading by the respondents seeking to invalidate the appellant's patent can never be overemphasised. A party attacking the validity of a patent should particularise the prior art in question in the pleading so that the parties and their experts may come to the trial prepared to meet the case which is intended to be proved against them, and that there may be no taking by surprise (see *Holliday v Heppenstall Bros* (1889) 6 RPC 320).

[38] In *Alsop Flour Process Ltd v Flour Oxidizing Co Ltd, Re Andrews' Patent* (1908) 25 RPC 477, the House of Lords refused to consider a non-pleaded prior art given the danger and unfairness that may occasion if it were to do so. Lord Loreburn observed as follows:

> I find that this Objection was not mentioned in the Particulars, and that though a few questions were put in cross-examination of the patentees' witnesses relating to the point, no notice was given of the purpose for which they were put, no amendment asked or granted at the trial, no such Objection made when Petitioners opened their case at the trial, and it was only in the petitioners' reply that the point was raised. Few things could be more dangerous or unfair than to admit now, in a case so complicated and full of details, an Objection which has such a history for these reasons I must decline to entertain it.

[39] Learned counsel for the appellant brought to our attention two High Court cases, namely *B Braun Melsungen AG & Anor v Terumo Kabushiki Kaisha & Anor* [2011] 6 AMR 101 and *Ranbaxy (Malaysia) Sdn Bhd v El Du Pont De Nemours & Co* [2011] MLJU 1135; [2011] 1 AMCR 857. Essentially, these cases have likewise required a party seeking to invalidate a patent on lack of novelty to plead and particularise all the relevant prior art relied on with specificity as a matter of

practice and prudence. The approach taken by these High Court cases is in accord with the principles derived from the cases that we have discussed earlier.

[40] Our attention was then drawn by learned counsel for the respondents to the case Merck *Sharp & Dohme Corp & Anor v Hovid Bhd* [2017] MLJU 77; [2017] 1 LNS 53 where the High Court took a different approach. The plaintiff in that case objected to the defendants reliance of two prior publications which had not been pleaded. The High Court dismissed the objection, among others, on the ground that it was clear from the amended defence and counterclaim where the words 'inter alia' were used that the publications pleaded as prior art were not exhaustive. We agree with the arguments of learned counsel for the appellant that the above approach in relying on qualifications such as 'inter alia' and 'limited to', which is similarly adopted by the Court of Appeal in the present case, are unprecedented in patent litigation as it is contrary to the basic principle of a full disclosure to prevent any surprise during the patent trial and to afford the plaintiff, particularly its experts, with the opportunity to deal with all the prior art relied on by the defendant

[41] In the present case, neither the appellant nor its experts were afforded the opportunity to scrutinise the Desa Kim Loong Machine in great detail and to submit their written opinions/reports on the same, as is the case in every patent trial. The respondents' introduction of the non-pleaded Desa Kim Loong Machine (in the form of a CD-ROM) at the eleventh hour and the Court of Appeal's decision to admit the same into evidence had handicapped the appellant in its defence of their patent's validity. In this way, the Court of Appeal's decision in admitting the Desa Kim Loong Machine and invalidating the appellant's patent based on the same had clearly prejudiced and caused injustice to the appellant.

[42] Based on all the above reasoning, we conclude that it is a requirement in law on the part of a party to plead with specificity the particulars of prior art a party intends to rely on to invalidate a patent for lack of novelty or otherwise.

[43] Even though *YKL Engineering* was decided in the context of an application to invalidate the registration of a patent on the ground that it was not new or lacked novelty, I find that the same principles about the applicant being required to plead with specificity the particulars of prior art disclosed to the public that it intends to rely on to invalidate a patent for lack of novelty can equally apply to an application to invalidate the registrar action of an industrial design for lack of novelty. I see no reason for the principle not to be applied.

[44] I also find that the plaintiff further failed to adduce at the trial any samples of any alleged *telekungs* or physical specimens or any other evidence of any alleged *telekungs* that had been disclosed to the public or were already being traded in the marketplace that would render the defendants' RID to be lacking in novelty or not new. In his *Pernyataan Saksi Plaintif* adduced at the full trial and marked as 'PS-SP1', Azrul Izzam (PW1), the plaintiff's Executive Chairman and Managing Director, also did not even mention any such telekungs.

[45] Consequently, I find that the plaintiff has altogether failed to establish any case for alleging that the defendants' RID are not new and that their registration ought to be revoked under s 27(1)(a) of the Act.

[46] Accordingly, the plaintiff's action to revoke the registration of the defendants' RID is dismissed with costs, subject to allocator.

D. INFRINGEMENT OF RID 44

[47] Part VI of the Act, is entitled 'INFRINGEMNENT', encompassing ss 32 to 35 of the Act. Section 32 provides as follows:

> 32 Infringement of registered industrial design.
>
> (1) Subject to the provisions of this Act, the owner of a registered industrial design shall have the exclusive right to make or import for sale or hire, or for use for the purposes of any trade or business, or to sell, hire or to offer or expose for sale or hire, any article to which the registered industrial design has been applied.
>
> (2) Subject to section 30, a person infringes the rights conferred by the registration of an industrial design if he, without the licence or consent of the owner of the industrial design, does any of the following things while the registration is still in force:
>
> (a) applies the industrial design or any fraudulent or obvious imitation of it to any article in respect of which the industrial design is registered;
>
> (b) imports into Malaysia for sale, or for use for the purposes of any trade or business, any article to which the industrial design or any fraudulent or obvious imitation of it has been applied outside Malaysia without the licence or consent of the owner; or
>
> (c) sells, or offers or keeps for sale, or hires, or offers or keeps for hire, any of the articles described in paragraphs (a) and (b).
>
> (3) Notwithstanding subsection (1), the right of the owner of a registered industrial design shall not extend to acts in respect of an article to which the registered industrial design is applied by or with the consent of the owner after the article has been lawfully imported into or sold in Malaysia.

[48] Thus, sub-s (1) of s 32 of the Act sets out the exclusive rights of the owner of a registered industrial design and sub-s (2) sets out the acts that would constitute infringement of that registered industrial design.

[49] Section 33(1) of the Act provides:

> The owner of a registered industrial design shall have the right to institute legal proceedings against any person who has infringed or is infringing any of the rights conferred by the registration of the industrial design.

[50] As the defendants' counterclaim is that the plaintiff has infringed RID 44, under s 33(1) of the Act, only the second defendant as its registered owner can bring the counterclaim for infringement of it.

[51] In *Redland Tiles Ltd & Ors v Kua Hong Brick Tile Works* [1966] 2 MLJ 62, the court held that whether or not there was infringement is a question of fact that is to be decided by the eye of the judge and the court. Abdul Aziz referred to the following passage in *Halsbury's* (3rd Ed) Vol 38 at p 675:

> The question whether a design which is alleged to infringe a registered design is or is not an infringement must be determined by the eye alone. The court has to decide only whether the alleged infringement has the same shape or pattern, and must eliminate the question of the identity of function, since another design may have parts fulfilling the same functions without being an infringement. Small differences in detail do not necessarily prevent infringement, but generally speaking, if under normal conditions of user the eye would not confuse the two designs, there is no infringement.
>
> If there is some outstanding feature of the registered design which is not reproduced, this would generally negative infringement It is not an actionable imitation merely to take the idea suggested by the design unless it works out in the way protected by the registration. Where an article may be readily manipulated into a position similar to the illustration of a design registration, there will be infringement

Abdul Aziz J then said: 'Therefore, the eye is the sole test …'.

[52] More recently, in *Dart Industries Inc & Anor v CMN International Sdn Bhd & Ors* [2019] MLJU 1252, Lim Chong Fong J (now JCA) said:

> [57] It can consequently be discerned that in the comparison of the features of shape and configuration of a registered industrial design with that of the alleged infringing product, the court's attention must be paid to only those features which 'appeal to the eye' and exclude from consideration features that would not qualify for registration such as functional features. It is in other words only the 'eye of the court' as the arbiter of not only what features of shape and configuration of the registered industrial design that has eye appeal but also what features of the alleged infringing product that ought to be taken into consideration when they are both compared.
>
> [58] The court must adopt the mantle of an interested customer and decide the question for itself and the decision cannot be delegated to witnesses as held in the English case of *Gaskell & Chambers v Measure Master Ltd*. Moreover in the case of *Isaac Oren v Red Box Toy Factory Ltd* [1999] FSR 875, it was held that evidence from an expert witness on the subject of how an ordinary consumer will perceive ordinary consumer goods is unlikely ever to be useful. Thus in *Dunlop Rubber Co Ltd v Golf Ball Developments Ltd*, the evidence of several witnesses who were put forth as being very familiar in the field of products to which the registered design in that case were

applied to and whether they would be confused between the alleged infringing product and the registered design on the basis that that was a conclusion only the court could arrive at was rejected.

[59] The provision in s 32(2) of the IDA is in *pari materia* with s 58 of the English Patents, Designs and Trade Marks Act 1883 which was then subsequently repealed and replaced by s 60 of the United Kingdom Patents and Designs Act 1907. Again in *Dunlop Rubber Co Ltd v Golf Ball Developments Ltd*, Farwell J held as follows in respect of obvious and fraudulent imitation as envisaged in s 32(2)(a) of the IDA with emphasis added by me:

> ... when the court is seeking to ascertain whether an alleged infringing design is an imitation or not, it is not the task of the court to determine aye or nay as a matter of fact, did the author of the alleged infringing design make use of the registered design? It is not necessary in order to determine the question for the court to know that the author of the alleged infringing design had the registered design before him, that he copied it, or anything of that kind. An alleged infringing design may be an imitation, although the author of it never knew of the registered design at all. Again in this section, the test is the eye, and in order to ascertain whether there is imitation or not, it is the eye that must be appealed to, and the two designs must be compared as a whole. It is necessary to look at the two design and to judge by the eye between them as to whether the one is an imitation of the other or not It is not a question of fact, eye or no, did the author of the infringing design in fact have before him, or have knowledge of, the registered design.
>
> ...
>
> Now with regard to the two words 'fraudulent' or 'obvious' in my judgment, 'obvious' means something which, as soon as you look at it strikes one at once as being so like the original design, as to be almost unmistakable. I think an obvious imitation is something which is very close to the original design, the resemblance to the original design being immediately apparent to the eye looking at the two.
>
> ...
>
> With regard to the word 'fraudulent, fraudulent I think does presuppose a knowledge of the registered design. I think it would be difficult for a court to come to the conclusion that an imitation was fraudulent unless the court was satisfied that the registered design had been known to the author of the alleged infringing design, and further, it seems to me that 'fraudulent imports something in the nature of making use of the registered design. It does not necessarily import deliberate intention to steal the property of the owner of the registered design ... [A] person may be the author of a fraudulent imitation believing perfectly honestly that he has so altered the registered design as to make them two different designs, and so far as his own mind and his own intention are concerned, he may be honest in that sense ...
>
> ...
>
> But fraudulent imitation seems to me to be an imitation which is based upon, and deliberately based upon, the registered design, and is an imitation which may be less apparent than an obvious imitation; that is to say, you may have a

> more subtle distinction between the registered design and a fraudulent imitation, and yet the fraudulent imitation, although it is different in some respects from the original, and in respects which render it not obviously an imitation may yet be an imitation perceptible when the two designs are closely scanned and accordingly an infringement.

[60] Moreover in the High Court of Australia case of *Polyaire Pte Ltd v K-Aire Ptd Ltd* [2005] HCA 32, it was held in interpreting s 30 of the Australian Designs Act 1906 which is also in pari materia with s 32(2) of the IDA that an example of a case of fraudulent imitation may be found is where the copy has differences which are both apparent and not so slight as to be insubstantial but which have been made merely to disguise the copying.

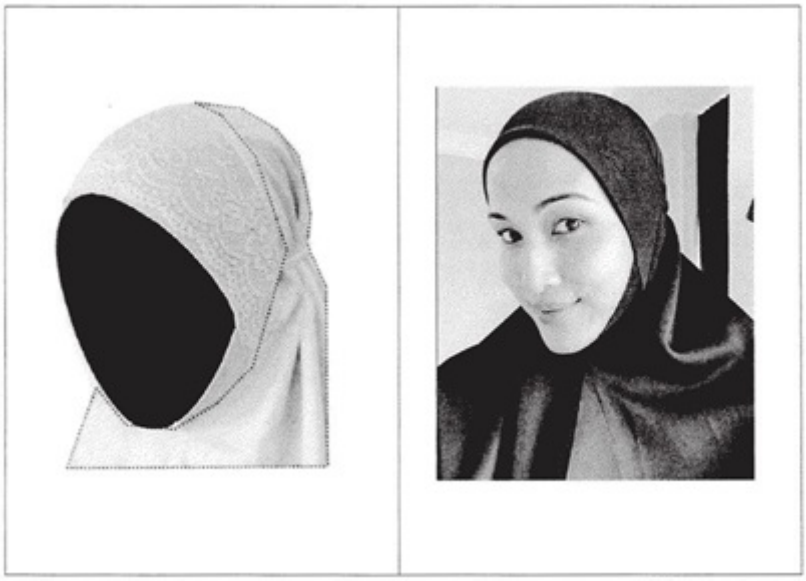
[61] It is therefore trite law that I am to adopt the visual eye appeal test in determining infringement. Farwell J in *Dunlop Rubber Co Ltd v Golf Ball Developments Ltd* explained the manner of applying this visual eye appeal test as follows:

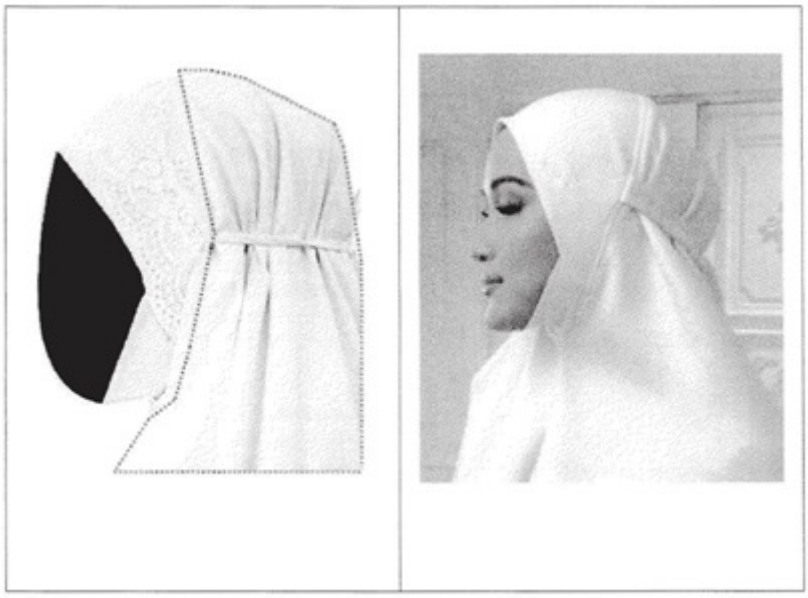
> It is a shape which immediately attracts one's eye and which is so striking a feature of the Design as to render it in my view easily distinguishable from every other design of golf ball which has been brought to my notice ... if a design has in it a striking feature which catches and holds the eye, and which is the one thing that strikes the eye when one looks at the design, a design which otherwise may be like a registered design but which eliminates the striking feature or alters it so that it is not recognisable in such a case it seems to me it is impossible to say that one is an imitation of the other. I think that anyone having seen and handled D5 looked at it and then put it away, and gone away, and then looked at the Maxfli ball, or was offered the defendants ball instead of it would at once perceive the difference and would at once have said: These two balls are not the same at all.
>
> ... That is the view I take from the use of my own eye. Looking at the design of D5, I get at once the impression of a star as the dominant feature in the Design something which I can carry away in my eye and which immediately distinguished the one from the other so that even after a considerable interval of time I recognise that a ball made in accordance with the registered Design is not the same thing as either the Penfold or the Bromford ball.
>
> *See also Hecla Foundry Co v Walker, Hunter & Co* [1889] 6 RPC 554.

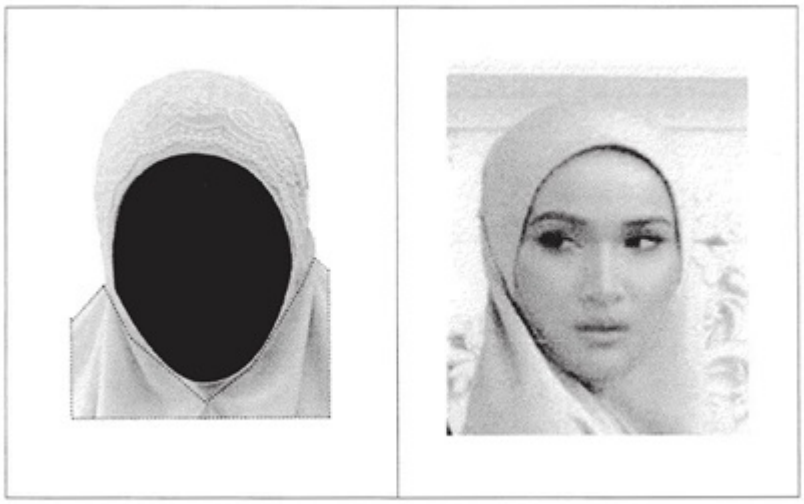
[62] Put simply, the comparison between the registered design and the alleged infringing product must be examined by viewing them as a whole, either by viewing them side by side or seeing what is the impression that is carried away by focusing on the registered design and whether that is present in the alleged infringing product even after a lapse of time. It is an objective test of the court in examining the commonalities as well as the dissimilarities seen therefrom giving particular weight to configuration and shape, see *Redland Tiles Ltd & Ors v Kun Hong Brick Tile Works*.

[53] The three-dimensional product emanating from RID 44 is the defendants' *Telekung Harmoni*. Below is what the defendants' *Telekung Harmoni* (left) and the plaintiff's *Telekung Suqainah Lite* (right) look like on

paper, side by side from a perspective view, a side view and a front view (reproduced from Bundle A at the trial):







[54] During the trial, physical samples of the defendants' *telekungs* (including the *Telekung Harmoni*) and plaintiffs' *Telekung Suqainah Lite* were also adduced and respectively marked as exhs D6 and P1.

[55] In her Expert Report, the defendants' expert witness, Prinses Saliang (DW2), said that she had examined all three of the defendants' *telekungs* represented by the defendants' RID and found that their essential feature is the face-opening design, consisting of two closely-fitting pieces of cloth covering from the face crown down to the chin that are stitched together in a way that one overlaps the other. In paras 3.1 (b) and (c) of her Expert Report she said:

> b) A visual assessment reveals that the distinctive feature shared by all Siti Khadijah's products is the face-opening design, which consists of closely fitting, two-pieces clothes, covering from the face crown down to the chin area.
>
> c) The face-opening design plays a pivotal role in establishing a strong visual association with Siti Khadijah brand, which can also be classified as an aesthetic attribute. The design enhances the aesthetics of the Telekung.

[56] In my view, eye appeal or function been in issue, those unrebutted and unchallenged statements by PW2 would have been grounds to dismiss that action for expungement under s 24(1) of the Act

[57] Having personally examined the physical samples of the defendants' *telekungs* (including the *Telekung Harmoni),* I find that DW2's description assessment of the essential features of the defendants' *telekungs* is accurate. I also found DW2 to not only be an expert witness but also a witness of truth whose evidence was unshakeable in cross-examination. Thus, I accept her evidence.

[58] Having then personally examined the physical samples of the plaintiff's *Telekung Suqainah Lite* and visually compared it with the defendants' *Telekung Harmoni,* I find that those essential features of the defendants' *Telekung Harmoni* are also present in and are essential features of the plaintiffs *Telekung Suqainah Lite.* I further surmise and find that, on the balance of probabilities, that was the result of copying and imitation by the plaintiff of the defendants' *Telekung Harmoni* that had already been sold and available in the marketplace well before the plaintiff started selling the plaintiff's *Telekung Suqainah Lite* in November 2021. In short, in the production, marketing and selling of the *Telekung Suqainah Lite,* the plaintiff has copied and imitated the defendants' *Telekung Harmoni.*

[59] I accordingly find that, on the balance of probabilities, the second defendant has successfully established and proven that the plaintiff has infringed the second defendant's RID 44. I therefore allow the second defendants' counterclaim against the plaintiff for infringement of the second defendants' RID 44 with costs, subject to allocatur.

E. SUMMARY OF CONCLUSIONS AND RELIEF/ORDERS

[60] The summary of my conclusions are:

(a) that the plaintiff's claim against the defendants is restricted to determining whether the defendants' RID should be revoked under s 27 of the Act;

(b) that on the evidence and on the balance of probabilities, the plaintiff has failed to prove its claim against the defendants to revoke the defendants' RID under s 27 of the Act; and

(c) that on the evidence and on the balance of probabilities, the second defendant has proven its counterclaim against the plaintiff for infringement of the second defendants' RID 44 under s 32 of the Act.

[61] Section 35 of the Act sets out the remedies for infringement of a registered industrial design. It provides:

> 35 Remedies for infringement
>
> (1) If the owner of a registered industrial design proves that an infringement has been committed or is being committed, the Court may award damages or an account of profits and may grant an injunction to prevent further infringement and any other legal remedies.
>
> (2) If the owner of a registered industrial design proves that acts are being performed which make it likely that an infringement will occur, that Court may grant an injunction to prevent infringement and any other legal remedies.

(3) The Court may refuse to award damages, or to make an order for an account of profits, in respect of an infringement, if the defendant satisfies the Court —

(a) that, at the time of the infringement, he was not aware that the industrial design was registered; and

(b) that he had, prior to that time, taken all reasonable steps to ascertain whether the industrial design had been registered.

(4) The Court shall refuse to award costs to the owner of a registered design who becomes entitled to the registered industrial by way of assignment or transmission or by operation of law or by a security interest transaction in respect of an infringement unless —

(a) an application to record his title or interest is made under section 30 before the end of the period of six months beginning from the date of the relevant transaction; or

...

(b) the Court is satisfied that it was not practicable for the said application to be made before the end of that period and that an application was made as soon as practicable thereafter.

[62] Now reverting to the relief and orders in paras 40(a) to (i) of the *tuntutan balas defendan-defendan*, I thereby make the following orders:

(1) Bahawa tuntutan plaintiff terhadap Defendan-defendan ditolak dengan kos, tertakluk kepada alokatur;

(2) Suatu perintah deklarasi bahawa Plaintif telah melanggar reka bentuk perindustrian berdaftar Defendan Kedua iaitu Pendaftaran No: MY 16-00044-0101 di bawah seksyen 32 Akta Reka Bentuk Perindustrian 1996;

(3) Suatu perintah injunksi untuk menghalang Plaintif sama ada melalui dirinya sendiri, pengkhidmat-pengkhidmatnya, ejen-ejennya, nama-namaannya dan/atau sesiapa sahaja yang telah diberi kuasa oleh Plaintif daripada terlibat dengan pengeluaran semula, pengiklanan, penjualan dan pengedaran dan/atau memberi kebenaran kepada pihak lain untuk terlibat dengan pengeluaran semula, pengiklanan, penjualan dan pengedaran reka bentuk telekung Plaintif di bawah sub-jenama Suqainah dan/atau sebarang reka bentuk telekung Plaintif di bawah sub-jenama Suqainah dan/atau sebarang reka bentuk lain yang meniru reka bentuk perindustrian Reka Bentuk Harmoni milik Defendan Kedua di bawah nombor pendaftaran MY 16-00044-0101;

(4) Ganti rugi am, pengajaran dan teruk (general, aggravated and exemplary damages), untuk ditaksirkan;

(5) Secara alternatifnya, satu akaun keuntungan berdasarkan hasil jualan reka bentuk telekung Plaintif di bawah sub-jenama Suqainah dan/atau sebarang reka bentuk lain yang meniru reka bentuk perindustrian Reka

Bentuk Harmoni milik Defendan-Defendan di bawah nombor pendaftaran MY 16-00044-0101 yang akan ditaksirkan oleh pihak Mahkamah;

(6) Faedah atas gantirugi atau akaun keuntungan yang ditaksirkan pada kadar 5% setahun dari tarikh tindakan iaitu 2/6/2022; dan

(7) Bahawa Plaintif membayar kos sebanyak RM70,000 kepada Defendan-defendan (secara kolektif), tertakluk kepada alokatur.

Order accordingly.

Reported by Nabilah Syahida Abdullah Salleh